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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,017	06/21/2003	Ronald Sherry	71-001	1016
31989	7590	12/10/2004	EXAMINER	
MITCHELL A. SMOLOW 720 HAMPTON ROAD SHAVERTOWN, PA 18708			O CONNOR, CARY E	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/604,017	SHERRY ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cary E. O'Connor	3732	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 04 October 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-25, 27 and 28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 27 and 28 is/are allowed.

6)  Claim(s) 1-25 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_  
  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-9, 11-21, 23, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caswell (965,079) in view of Milano (2,831,480). Caswell shows a shield comprising a handle 5 having a first end for gripping and a second end. A substantially flat first shield 2 has an anterior end connected to the handle second end and has a posterior end and an inferior border. A non-hinging transverse member 3 has a first end connected to the first shield posterior end, a second end and an inferior border. A second shield 2 has an anterior end, a posterior end and an inferior border. The transverse member inferior border does not extend as far inferiorly as the first and second shield inferior border (see Figure 3). The handle, first shield, transverse member or second shield does not "transition" into each other as claimed by applicant. Milano shows a shield comprising a handle, first shield, transverse member and second shield wherein the shield is formed in one piece and transition into one another. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the shield of Caswell in one piece, as taught by Milano, in order to provide a more sanitary device because of the elimination of connection areas that could collect bacteria. As to claim 2, it is well known to form dental instruments of a

sterilizable material to prevent cross contamination. As to claim 7, since the handle is meant for gripping, it inherently has a cross section of a geometric shape that will permit effective gripping. As to claim 9, the first and second shields are "substantially" planar and oriented in a "substantially" vertical dimension. As to claim 11, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caswell (965,079) in view of Milano (2,831,480) as applied to claim 1 above, and further in view of Lauderdale (990,277). As to claim 3, Caswell discloses that the inner surfaces of the shields may have mirrors (lines 66-70). Lauderdale shows a shield having a highly polished reflective surface (page 1, lines 89-91). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the mirrors of Caswell with a highly polished reflective surface, in view of Lauderdale, in order to provide a more sanitary device by elimination crevices. As to claim 10, Caswell does not show the second shield as having an anterior flare or being cupped. Lauderdale shows a shield wherein the second shield 8 is cupped to minimize discomfort (page 1, lines 53-60). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to cup the second shield of Caswell, as taught by Lauderdale, in order to minimize discomfort to the patient.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caswell (965,079) in view of Milano (2,831,480) as applied to claim 1 above, and further in view of Hertz (5,813,857). The shield of Caswell does not include an access opening in one of the first and second shields. Hertz shows a shield device having an access opening 30 so that a saliva ejector may be introduced therethrough. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide one of the first and second shields of Caswell with an access opening, in view of Hertz, so that a saliva ejector could be placed and held in the mouth by the shield.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caswell (965,079) in view of Milano (2,831,480) as applied to claim 24 above, and further in view of Hachman (1,498,267). Neither Caswell nor Milano disclose that a moisture barrier is secured by the shield. Hachman shows a dental shield for isolating the cheek, lip and tongue. Hachman teaches that a moisture barrier may be secured with the shield (page 1, lines 59-61), thereby eliminating a need for an assistant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to secure a moisture barrier with the shield of Caswell as modified by Milano, in view of Hachman, so that excess moisture may be absorbed during the procedure without the use of a suction wand.

***Allowable Subject Matter***

Claims 27 and 28 are allowed.

***Response to Arguments***

Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 571-272-4715. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Cary E O'Connor*  
Cary E. O'Connor  
Primary Examiner  
Art Unit 3732

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